

REMARKS

These Remarks are responsive to the Office Action mailed November 17, 2004 (“Office Action”). Applicant respectfully requests reconsideration of the rejections of claims 1-32 for at least the following reasons.

STATUS OF THE CLAIMS

Claims 1-32 are pending in the application. No claims have been amended.

REJECTIONS UNDER 35 U.S.C. § 103

The Office Action has rejected claims 1-3, 6-9, 17-19, 24-26 and 29-32 under 35 U.S.C. § 103(a) as allegedly being unpatentable over Haseltine et al. (US 6,578,015) in view of Hogan (US 5,599,528).

Claim 1 recites that “electronic summary can be printed out to serve as a remittance slip in a traditional method of payment of the at least one bill by the at least one payer.”

The Office Action states that Haseltine fails to disclose that “the electronic summary can be printed out to serve as a remittance slip in a traditional method of payment ... whereby the at least one payer retains control of the bill payment process by the traditional method.” Additionally, Haseltine teaches away from combining an electronic notification with paper payment of bills: “Such methods, devices and systems should also allow customers to view and pay bills without the disadvantages associated with ... paper bills and checks.”

Hogan fails to add what Haseltine lacks. Haseltine fails to teach or disclose that “the electronic summary can be printed out to serve as a remittance slip in a traditional method of payment ... whereby the at least one payer retains control of the bill payment process by the traditional method.” Hogan discloses that users can “print the bills on printers ... and download them **for storage**.” Col. 5, Ins. 8-9. Hogan teaches away from combining an electronic notification with paper payment of bills: “some of the major shortcomings of the prior-art bill paying techniques are that a user is required to inconveniently go through multiple steps to have

their bills paid (including manually receiving each bill, reviewing and storing it)” Col. 1 ln. 65 - Col. 2, ln. 2.

To establish a *prima facie* case of obviousness under § 103, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art to modify the reference to combine the teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references combined) must teach or suggest all of the claim recitations. MPEP 706.02(j). Further, the teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, not based on applicants' disclosure. *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991).

Neither Haseltine nor Hogan teach or suggest “electronic summary can be printed out **to serve as a remittance slip in a traditional method of payment** of the at least one bill by the at least one payer.” In fact, both Haseltine and Hogan teach away from combining electronic and traditional methods in this way. The specification of the present application states that “Present electronic bill paying systems do not facilitate the kind of control that payers are accustomed to having in a traditional paper system such as cash or checks.” Specification, p. 2. Applicants respectfully submit that claim 1 is not obvious in light of Haseltine and Hogan. Accordingly, applicant respectfully requests that the rejection of independent claim 1 be withdrawn. Independent claims 19 and 24 contain similar limitations to claims 1, thus the applicant respectfully requests that the rejection of independent claims 19 and 24 be withdrawn for the reason above. Further, if an independent claim is nonobvious under 35 U.S.C. 103, then any claim depending therefrom is nonobvious. *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988). Accordingly, the rejection of the dependent claims 2, 3, 6-9, 17, 18, 25-26 and 29-32 is likewise improper, and Applicant respectfully requests that it be withdrawn.

The Office Action has rejected claims 4, 5, 10-16, 20-23, 27 and 28 under 35 U.S.C. § 103(a) as allegedly being unpatentable over Haseltine et al. (US 6,578,015) as modified by Hogan (US 5,599,528) as applied to claim 1 as discussed above, and further in view of Schutzer

Appln. No. 09/772,601
Amdt. dated March 17, 2005
Response to Office Action Mailed November 17, 2004

(US 6,291,789) and Hilt et al (US 5,465,206). If an independent claim is nonobvious under 35 U.S.C. 103, then any claim depending therefrom is nonobvious. In re Fine, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988). Accordingly, the rejection of the dependent claims 4, 5, 10-16, 20-23, 27 and 28 is improper for the reasons stated above in regard to claims 1, 19 and 24, and Applicant respectfully requests that it be withdrawn.

CONCLUSION

Applicants respectfully submit that this application is in condition for allowance and such disposition is earnestly solicited. If the Examiner believes that a telephone conference or interview would advance prosecution of this application in any manner, the undersigned stands ready to conduct such a conference at the Examiner's convenience.

The fee associated with the one month extension for this Response is contained in the attached check. Nevertheless, in the event that the U.S. Patent and Trademark Office requires a fee to enter this Reply or to maintain the present application pending, please charge such fee to the undersigned's Deposit Account No. 50-0206.

Respectfully submitted,

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By:


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